

REMARKS

Applicants have considered the July 25, 2007 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-4, 6-13 and 15-26 are pending in this application.

By way of the present Amendment, Applicants have amended claims 18, 21, 22 and 24. No new matter has been added. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter. Claims 1-4 and 6-12 were allowed. Claims 13 and 15-17 would be allowed if the rejection under the second paragraph of 35 U.S.C. § 112 were overcome. Claim 20 would be allowed if recast in independent form and rewritten to overcome the rejection under the second paragraph of 35 U.S.C. § 112. Claims 23 and 26 would be allowed if recast in independent form.

Claims 13 and 15-20 were rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully request reconsideration and withdrawal of the rejection in view of the foregoing amendments to the claims and the following remarks.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. *Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the PTO is required to discharge its initial burden for providing a basis in fact and/or cogent reasoning to support the

ultimate legal conclusion that one having ordinary skill in art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by the claim.

In re Cortright, 165 F.3d 1353, 49 USPQ 2d 1464 (Fed. Cir. 1999). Consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Miles Laboratories, Inc. v. Shandon, Inc.*, 27 USPQ 2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. American Cyanamide Co.*, 28 USPQ 2d 1333 (Fed. Cir. 1993); *U.S. v. Teletronics, Inc.*, 8 USPQ 2d 1217 (Fed. Cir. 1988). Applicant stresses that a patent specification must be viewed through the eyes of one having ordinary skill in the art. *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

In applying the above legal tenets to the exigencies of this case, Applicants submit that one having ordinary skill in the art would not have been befuddled by the use of the following phrase in claim 13: "the high resistance region is formed separately from dislocations", particularly as employed in the context of the claimed invention. This phrase simply means that the carbon containing region is formed by a process step different from that of the dislocations. As such, one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed invention, particularly when reasonably interpreted in light of the supporting specification.

With respect to claim 18, the phrase "provided with a region of the front surface" refers to the front surface of the semiconductor element layer. Claim 18 has been amended to clarify this point.

Therefore, it is respectfully submitted that the imposed rejection under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicants solicit withdrawal thereof.

It is believed that the claim objection of claims 21, 22 and 24 has been overcome with the foregoing amendments to the claims. Accordingly, reconsideration and withdrawal of the objection are solicited.

Claims 18, 19, 21, 22, 24 and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yamaguchi et al. (U.S. Pat. App. Pub. No. 2001/0032975, hereinafter “Yamaguchi”). Applicants traverse.

Claim 21 was rejected under 35 U.S.C. § 102(b) as being anticipated over Nagahama (JP 2002-033512). Applicants traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Independent claims 18, 21 and 24 have been amended to further recite “a back electrode provided on a back surface of said substrate”. Fig. 3 of Yamaguchi shows the electrodes 105 and 115 formed on the front surface of the device but not “a back electrode provided on a back surface of a substrate” as required in each of claims 18, 21 and 24. As with Yamaguchi, Nagahama fails to disclose “a back electrode provided on a back surface of a substrate”. Thus,

the above argued difference between the claimed subject matter and the devices disclosed by Yamaguchi and Nagahama, undermines the factual determinations that Yamaguchi and Nagahama disclose the identical subject matter as claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejections under 35 U.S.C. § 102 for lack of novelty as evidenced by Yamaguchi and Nagahama are not factually viable and, hence, solicit withdrawal thereof.

Applicants note the Examiner's Statement of Reasons for Allowance included on page 9 of the Office action. Entry of that Statement into the record should not be construed as any agreement with or acquiescence by Applicants in the reasoning stated by the Examiner. Applicants positions on the issues appear in Applicants' responses. *Salazar v. Procter & Gamble Co.*, 414 F.3d 1342 (Fed. Cir. 2005). The Statement of Reasons for Allowance should not be used to interpret the cited claims, particularly to the extent if any that the Statement of Reasons for Allowance may differ from the express language of the claims and/or Applicants' positions on patentability of those claims. It is respectfully submitted that the allowed claims should be entitled the broadest reasonable interpretation and broadest range of equivalents that are appropriate in light of the language of the claims, the supporting disclosure and Applicants' prosecution of the claims, without reference to the Statement of Reasons for Allowance.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an

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Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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